



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,488	08/09/2006	Steven Weber	ESSR:098US/10510809	1295

32425 7590 09/09/2009
FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN, TX 78701

EXAMINER

PEZZUTO, HELEN LEE

ART UNIT	PAPER NUMBER
----------	--------------

1796

MAIL DATE	DELIVERY MODE
-----------	---------------

09/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,488	Applicant(s) WEBER ET AL.	
	Examiner Helen L. Pezzuto	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 64-127 is/are pending in the application.
- 4a) Of the above claim(s) 83-127 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 64-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 64-127 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/17/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 64-82 in the reply filed on 8/5/09 is acknowledged. The traversal is on the ground(s) that all the Groups of inventions as set forth in the restriction requirement are linked as to form a single general inventive concept that all of them involve the composition as defined in claim 64. This is not found persuasive because the inventions listed as Groups 1-IV lack the same or corresponding special technical features. The claims of Groups I-IV share the composition as the special technical feature, which is considered to lack novelty or an inventive step in view of the references set forth in the International Search Report (i.e. WO 01/94430) and further in view of the references herein cited.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 83-127 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/5/09.

Priority

3. It is noted that this application appears to claim subject matter disclosed in prior Application No. 10/417,525, filed 17 April 2003. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national

Art Unit: 1796

stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a),

Art Unit: 1796

but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

In the instant application, for benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation-in-part) of all nonprovisional applications in the first page of the specification.

Claim Objections

4. Claim 81 is objected to because of the following minor informalities: Do applicants intend "0.1" on line 2? Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1796

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 64-69, and 72-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Jiang (US-323).

US 6,184,323 B1 to Jiang discloses and exemplifies a photopolymerizable composition comprising 10-70 wt% of a difunctional thio(meth)acrylate as set forth in formula (I), 10-60 wt% of at least one monomer as set forth in formula (III), 5-30 wt% of an aromatic or polycyclane mono(meth)acrylate as set forth in formula (IV), and up to 15 wt% of a polyalkylene glycol di(meth)acrylate, which fall within the scope of the recited polymerizable monomer/oligomer (B), (C), and (A), respectively (see abstract; col. 2, line 50 to col. 4, line 67; working examples). Specifically, suitable polycyclane mono(meth)acrylate and polyalkylene glycol di(meth)acrylate species are disclosed within the scope of the instant mono or polyacrylate or oligomer (A) (col. 5, lines 1-37). Furthermore, prior art teaches incorporating 0.001 to 5 wt% of a photoinitiator (col. 6, lines 44-56; working Examples, Table 1). The resultant compositions have refractive index within the range expressed in claim 82 (cols. 7-8, Table 1). Thus, anticipating the present claims.

Art Unit: 1796

7. Claims 64, 72-73, 75, and 77-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Jiang et al. (US-606).

US 6,479,606 B1 to Jiang et al. discloses and exemplifies a photopolymerizable composition with high refractive index, comprising at least one polythio(meth)acrylate monomer (A) as defined by formula (I), at least one monomer (B) having at least two polymerizable groups, at least one polythiol monomer, and at least one other comonomer (D), within the scope of the instant compositions (col. 2, lines 7-67; working Examples; Table 1). Specifically, prior art monomer (B) as set forth in formulas (III) and (IV) embraces the instant (A) monomer (col. 8, line 66 to col. 10, line 67), and monomer (D) as set forth in formula (IX) embraces the instant (C) monomer (col. 17, lines 1-33). Prior art further discloses and exemplifies 0.001 to 5 wt% of photoinitiator and the resultant compositions have refractive index within those expressed in claim 82 (col. 17, line 56 to col. 18, line 46; Tables II, IV, V). Thus, anticipating the present claims.

8. Claims 64-69, 72-75, and 77-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Keita et al. (US-831) or Fukushima et al. (US-550).

US 5,741,831 to Keita et al. discloses and exemplifies photopolymerizable composition comprising at least 10 wt% of at

Art Unit: 1796

least one thio(meth)acrylate monomer (I), up to 90 wt% of one or more mono- or polyfunctional monomer (II), within the scope of the instant (B), (A), and (C), respectively (see abstract; working Examples). Specifically, prior art monomer (I) encompasses the instant (B) (col. 2, line 1 to col. 6, line 61), and monomer (II) maybe a mixture of polyalkylene glycol di(meth)acrylate and monomer of formula (IV), corresponding to the instant (A) and (C) monomers (col. 7, line 52 to col. 8, line 50; working Examples; Tables 1-2). Prior art further suggest incorporating a photoinitiator in the claimed amount (col. 9, lines 47-59; working Examples). The resultant compositions have refractive index values within those expressed in claim 82 (cols. 11-12, Table 2). Thus, anticipating the present claims.

US 6,206,550 B1 to Fukushima et al. discloses and exemplifies an active energy ray curable composition suitable for the manufacturing of optical lenses, comprising 20-80 parts by weight of monomer (A) as defined by formula (I), 20-80 parts by weight of at least one monomer (B) having at least one (meth)acryloyl functionality, and 0.01 to 5 parts by weight of a photoinitiator (see abstract; col. 2, line 11-46). Specifically, prior art component (A) is taught within the scope of the instant (B), and component (B) maybe be one or more of

Art Unit: 1796

polyalkylene glycol di(meth)acrylate and ethoxylated bisphenol A di(meth)acrylate, taught within the scope of the instant (A) and (C) monomers (col. 4, lines 5-12; col. 5, line 21 to col. 6, line 45); working Examples). The resultant compositions have refractive index values within those expressed in claim 82 (see Tables 1-3). Thus, anticipating the present claims.

9. Claims 64-69 and 72-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Oshikiri et al. (US-953).

US 6,699,953 B2 to Oshikiri et al. discloses and exemplifies a photopolymerizable resin composition for optical lenses. One of prior art embodiments comprises 20-80 wt% of bis-2-methacryloylthioethyl sulfide as set forth in formula (1), 5-50 wt% of a bifunctional or multifunctional thiol, , 5 to 50 wt% of a bifunctional (meth)acrylic compound [A], and up to 75 wt% of a comonomer (see abstract; col. 3, line 64 to col. 4, line 26). Suitable bifunctional (meth)acrylic compound [A] include polyalkylene glycol di(meth)acrylate and 2,2-bis(4-((meth)acryloxy polyethoxy)phenyl)propane, taught within the scope of the instant (A) and (C) monomers (col. 5, lines 6-51; working Examples). Prior art further exemplifies using 1000 ppm of a photoinitiator IRGACURE 184, and the resultant refractive index values fall within the range expressed in claim 82 (cols.

Art Unit: 1796

9-10, Table 1; cols. 11-12, Table 2). Thus, anticipating the present claims.

Claim Rejections - 35 USC § 102/103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 70-71 are rejected under 35 U.S.C. 102(b) or 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jiang et al. (US-323 or US-606) or Keita et al. (US-831) or Fukushima et al. (US-550) or Oshikiri et al. (US-953) for the reasons set forth in the preceding paragraphs and further in view of the following remarks.

Prior art references discloses and exemplifies the presently claim composition within the recited proportions. The references are silent regarding the solubility parameter of monomer (A) as expressed in claims 70-71. The examiner is of the position that once the selection of suitable monomer (A) species is provided and carried out, the recited solubility property would be an inherent characteristic in prior art monomer (A),

and thus, would necessarily flows from the teaching of the applied prior art.

Claim Rejections - 35 USC § 103

12. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keita et al. (US-831) or Fukushima et al. (US-550) for the reasons set forth in the preceding paragraphs and further in view of the following remarks.

US-831 and US-550 discloses and exemplifies the claimed composition in the recited amounts. While prior art expressively discloses the specific monomer (A) species as expressed in claim 76, the references do not exemplify them in conjunction with the claimed (B) and (C) monomers. Since US-831 and US-550 expressively suggest using one or more of monomer (A) and (C) in the recited proportions (see US-831, col. 7, line 52 to col. 8, line 50; US-550, col. 3, line 58 to col. 4, line 30), it would have been obvious to one having ordinary skill in the art to employ a mixture of (A) and (C) as taught, motivated by the reasonable expectation of success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Helen L. Pezzuto/
Primary Examiner
Art Unit 1796

hlp